REMARKS/ARGUMENTS

This Amendment is in response to the Office Action mailed 01/12/2004. In the Office Action, claims 1-3, 5-9 were rejected under 35 U.S.C. § 101. Claims 1-2, 6-7, 9-11, 15-16, 18-20, 24-25, 27-29, 33-34 and 36 were rejected under 35 U.S.C. § 102, and claims 3-5, 8, 12-14, 17, 21-23, 26, 30-32, and 34 were rejected under 35 U.S.C. § 103. Reconsideration in light of the amendments and remarks made herein is respectfully requested.

Claims 1-36 remain in this application.

It is respectfully requested that the Examiner contact the undersigned attorney to discuss the grounds for traverse. The undersigned attorney can be contacted at the telephone number listed below.

Rejection Under 35 U.S.C. § 101

In the Office Action, claims 1-3, 5-9 were rejected under 35 U.S.C. § 101 because the claimed invention is allegedly an abstract idea, and thus is directed to non-statutory subject matter. Applicants respectfully disagree.

A claimed invention is an abstract idea if it does not have any practical application or does not perform any concrete act. See Schrader, 22 F.3d 290, 293-294, 30 USPQ2d 1455, 1458-1459, Warmerda, 33 F.3d 1354, 1360, 31 USPQ2d 1754, 1759, MPEP § 2106. A process is statutory if it requires physical acts to be performed outside the computer independent of and following the steps to be performed by a programmed computer, where those acts involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure. Diamond v Diehr, 450 U.S. 175, 187, 209 U.S.P.Q 1, 8. Thus, if a process claim includes one or more process steps that result in a physical transformation outside the computer, the claim is clearly statutory.

Here, claim 1 recites the operation "detecting a tuning event," "maintaining relative statistics on one or more items related to the tuning event," and "creating automatically a list of favorites based on the maintained relative statistics." First, the claimed invention has a practical application in the interactive television arts. It provides convenience to the viewer in viewing favorite television programs. On that basis alone, the claimed invention is statutory.

Second, the acts recited by the claims involve the manipulation of tangible physical objects and result in the object having a different physical attribute or structure. For instance, the "tuning event" is a tangible physical object, for example, a channel selection. "One or more items" related to the tuning event is also a physical object; for example, the channel, the program, etc. "A list of favorites" is also another tangible physical object. The acts "detecting," "maintaining," and "creating" clearly transforms the "tuning event" into "relative statistics" and finally into "a list of favorites."

Accordingly, Applicants respectfully request that the Examiner withdraw the rejection of claims 1-3, 5-9 under 35 U.S.C. § 101.

Rejection Under 35 U.S.C. § 102

The Office Action states that (1) claims 1, 2, 6, 9, 10, 11, 15, 18, 19, 20, 24, 27, 28, 29, 33, and 36 are rejected under 35 U.S.C. § 102(e) as being anticipated by Wugofski (US 2003/0056216 A1), (2) claims 1, 7, 10, 16, 19, 25, 28, and 34 are rejected under 35 U.S.C. § 102(b) as being anticipated by Lawler (US Patent 5,758,259) and claims 1, 10, 19, and 28 are rejected under 35 U.S.C. § 102(b) as being anticipated by Wehmeyer (US Patent 5,867,226). Applicants respectfully traverse the rejection and contend that a *prima facie* case of anticipation for each rejection has not been established. However, before discussing the reasons for traverse, a brief summary of the cited references may be appropriate.

Wugofski discloses a system for managing favorite channels. The system identifies channels showing events relating to the user specified theme and include the events in the favorites list (Wugofski, paragraph [0010]). The most frequently used channels are stored in a favorite channel list for a particular user (Wugofski, paragraph [0011]). The user can have favorites lists organized by theme or by the user's actual usage of the computerized system (Wugofski, paragraph [0045]).

Lawler discloses automated selective programming guide. A viewer preferences database represents a viewing history that forms a basis for identifying future preferred programming for the viewer (Lawler, col. 5, lines 56-59). The predetermined characteristics may include programming type (e.g., movie, talk show, sports) as well as data regarding selected fields for each programming type (Lawler, col. 6, lines 2-9).

Wehmeyer discloses scheduler employing a predictive agent for use in a television receiver. A record is kept of the user's viewing habits so that the apparatus can be guided to make a prediction of which upcoming shows may be of interest to the viewer (Wehmeyer, col. 2, lines 37-40).

As the Examiner is aware, to anticipate a claim, the reference must teach every element of a the claim. "A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference." Vergegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987). "The identical invention must be shown in as complete detail as is contained in the...claim." Richardson v. Suzuki Motor Co., 868 F.2d 1226, 1236, 9 USPQ 2d 1913, 1920 (Fed. Cir. 1989).

Applicants respectfully submit that neither Wugofski, Lawler, nor Wehmeyer disclose "detecting a tuning event", "maintaining relative statistics on one or more items related to the tuning event", and "creating automatically a list of favorites based on the maintained relative statistics." Wugofski merely discloses storing the most frequently used channels in a favorite channel list or based on the actual usage of the user. Lawler and Wehmeyer merely disclose keeping track of the user's viewing habits or history to determine future program preferences.

Moreover, none of the prior art references disclose use of relative statistics. In contrast, the claimed invention recites "relative statistics". As an example, relative statistics may be maintained by subtracting a certain percentage from the count value of each item. See, for example, Specification on page 17, lines 7-8.

Accordingly, Applicants respectfully request the rejections under 35 U.S.C. § 102(e) be withdrawn.

Rejection Under 35 U.S.C. § 103

The Office Action states that (1) claims 3, 12, 21 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wugofski in view of Perlman (US Patent 5,583,576), (2) claims 3, 12, 21 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Perlman, (3) claims3, 12, 21 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wehmeyer in view of Perlman, (4) claims 4, 13, 22 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wehmeyer in view of Levitan (US Patent 5,534,911), (5) claims 4, 13, 22 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wugofski in view of Levitan, (6) claims 4, 13, 22 and 31 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Levitan, (7) claims 5, 14, 23 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of official notice, (8) claims 5, 14, 23 and 32 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wugofski in view of official notice, (9) claims 8, 17, 26 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wugofski in view of Zahavi (U.S. Patent 5,410,367), (10) claims 8, 17, 26 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Wehmeyer in view of Zahavi and (11) claims 8, 17, 26 and 35 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Lawler in view of Zahavi. Applicants respectfully traverse the rejection and contend that a prima facie case of obviousness for each rejection has not been established. Moreover, Applicants reserve the right to challenge the official notice in accordance with MPEP § 2144.03.

Perlman discloses a rating-dependent parental lock-out for television reception using electronic program guide (EPG). The EPG data may comprise daily, weekly, or monthly program schedule data (Perlman, col. 10, lines 3-8).

Levitan discloses a virtual personal channel in a television system. Automated channel control service is provided by transmitting data on scheduled television programs prior to the programs (Levitan, col. 1, lines 45-48). The channel selector is switched to a proper channel at a proper time in order to keep the video receiver set for reception of selected program (Levitan, col. 1, lines 51-54).

Zahavi discloses television program scheduler for providing an indication to a user that a television program is about to start. This is done by increasing the rate of flashing of display or the level of sound emitted by buzzer as the time kept by a clock approaches the start time of a scheduled television program (Zahavi, col. 5, lines 50-56).

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. MPEP §2143, p. 2100-124 (8th Ed., rev. 1, Feb. 2003). Applicants respectfully

contend that there is no suggestion or motivation to combine their teachings and that no *prima facie* case of obviousness has been established.

Neither of Perlman, Levitan, Zahavi nor the official notice, alone or in combination discloses or suggests "detecting a tuning event", "maintaining relative statistics on one or more items related to the tuning event", and "creating automatically a list of favorites based on the maintained relative statistics." For instance, contrary to the Examiner's position, Perlman merely discloses the EPG includes weekly programs, not a list of favorites as recited in claim 3. Lawler merely discloses switching a channel selector, not auto-tuning the list of favorites, as recited in claim 4. Official notice merely states using a user ID and password to access information, not accessing the list of favorites from more than one device. Zahavi merely discloses providing an indication that a program is about to start, not an item in the list of favorites is about to start. Applicants respectfully request the Examiner to provide specific recitations of such suggestion if the rejection is maintained.

In view of the above, there is no motivation to combine Perlman, Levitan, Zahavi and official notice in any combination.

Accordingly, Applicants respectfully request the rejections under 35 U.S.C. § 103(a) be withdrawn.

Conclusion

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

Respectfully submitted,

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